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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,562	08/09/2001	G. David Jang	S63.2-9950	6986

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VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/925,562	Applicant(s) JANG, G. DAVID	
	Examiner Paul B. Prebilic	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-36, 39-43, 47, and 49-62 is/are pending in the application.
 4a) Of the above claim(s) 60 and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-36, 39-43, 47, 49-59 and 62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Claims 60 and 61 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 8, 2004. It is noted that Applicant stated that all the claims read on the elected species M (Figure 10F). However, claims 60 and 61 were withdrawn because no support could be found for "circumferentially aligned" joining struts in Figure 10F. Support for this limitation was found in Figure 3A, however. Particularly, the Examiner concluded that struts (30) (the joining struts of Figure 10F) are not "circumferentially aligned" but are offset with respect to the true circumferential direction.

The traversal is on the ground(s) that species 10F can be used with any other embodiment. This is not found persuasive because the species are mutually exclusive and a combination of them would merely be a combination of mutually exclusive species in a similar manner to that of the elements of a Markush listing.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 51-59 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claim 51-59 and 62 (see the copy of the claims filed June 30, 2004), in claim 51, lines 7 and 14, claim 57, line 7, claim 60, line 4, and claim 62, line 4, since there is no inherently round or cylindrical structure claimed for the stent, the terminology "the circumference of the stent" lacks antecedent basis rendering the claim language indefinite. For example, stents can be in a folded or spiral shape when in their unexpanded form. The claims dependent upon these claims are rendered indefinite since they contain the same language by incorporation.

In claim 58, line 2, claim 59, line 2, claim 60, lines 3, 7, and 11, since there is no shape set forth for the stent, one cannot determine what "the longitudinal axis of the stent" is as claimed. For this reason, the claim language is considered indefinite.

In claim 60, lines 21-23 and lines 29-30, and claim 62, lines 17-18 and lines 23-24, the language "circumferentially and longitudinally offset" and "circumferentially aligned" does not make since there is no shape set forth for the stent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 34-36, 39-43, 47, 49, 50, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (US 6,348,065) in view of Pinchasik et al (US 5,449,373).

Brown discloses a thin walled metal tube (see column 3, lines 13-17), the first, second and third expansion columns are met by the adjacent segments (16) of Brown (see Figures 1 to 5), and the connecting strut columns as claimed are made up of interconnecting elements (20) between segments (16). Brown shows that the ends of the connecting struts are closer to one of the expansion struts than to the other. However, Brown fails to disclose curved connectors as claimed. However, Pinchasik teaches that it was known to make curved longitudinally and circumferentially offset connectors between adjacent segments; see Figures 2A to 2C. Therefore, the Examiner posits that it would have been obvious to make the connectors of Brown curved for the same reasons that Pinchasik does the same and in order to better support the area between the segments. Pinchasik further teaches that the connecting strut can be closer to one strut of the strut pair.

With regard to claims 35 and 41, Brown does not disclose the claimed ratio. However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to increase the number of connectors, especially in view of the prior art shown in Figure 1 of Pinchasik, because Applicants have not disclosed that the claimed ratio has some advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicants'

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invention to perform equally well with more connectors so that the ratio would be 2 to 1 as claimed. Therefore, it would have been an obvious matter of design choice to modify Brown to obtain the invention as specified in the claims.

Claims 51-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al (US 5,733,303) [in view of] or Richter or (US 5,807,404). Israel (see Figure 1) or Richter (see Figure 1) meets the claim language except for the circumferentially offset position of the first (and/or second) ends of the connectors as claimed. However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to circumferentially offset the ends of the connectors because Applicants have not disclosed that doing so provides some advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicants' invention to perform equally well because a slight position change of the ends is all that is required to meet the claim language and because it would not appreciably change the function of the stent to have a slight offset. Therefore, it would have been an obvious matter of design choice to modify Israel or Richter to obtain the invention as specified in the claims.

Response to Arguments

Applicants' arguments filed February 11, 2005 have been fully considered but they are not persuasive.

With regard to the Section 112 rejection traversal that these claims have been prosecuted for some time, the Examiner takes the position that the fact that

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certain ambiguities have been unnoticed up to this point does not justify letting them go uncorrected when there is an opportunity to correct them. In a claim set as extensive as this one (10 pages, 22 claims, and 9 independent claims), it is difficult to catch all ambiguities in the limited amount of time given for examination. Applicant could have relatively easily eliminated the ambiguities by amending the claims in the fashion of the other claims that are not rejected under Section 112.

In response to the argument that there is no motivation to combine Brown and Pinchasik because the connectors have different flexibilities, the Examiner asserts that since Pinchasik was not used to show flexibility of connectors, the argument is not directed to the teaching of Pinchasik. In other words, Applicant is arguing Pinchasik individually and not as the teaching reference that it was intended to be. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, since the combination can be for a different reason than that of Applicant, the argument that the connectors of Pinchasik does not have all the characteristics of the connectors of Brown is not a persuasive way to argue unobviousness.

Applicant argues that Israel and Richter fail to provide a motivation to make the change to circumferentially offset connector ends. However, since the present claims only require a slight offset, the claimed invention is obvious in view of these references because there is no showing and "Applicants have not

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disclosed that doing so provides some advantage, is used for a particular purpose, or solves a stated problem.” In other words, the difference is so slight between the claimed invention and the prior art that it cannot be considered patentable absent showing of an advantage, purpose, or problem solved. Furthermore, the difference is so slight that one could argue that it is inherently met because machine tolerances do not allow perfect alignment of the ends.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office

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action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul B. Prebilic
Primary Examiner